



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,178	11/07/2001	Robert A. Pyles	Mo-6825/MD-01-39-KU	9063

157 7590 03/28/2003

BAYER POLYMERS LLC
100 BAYER ROAD
PITTSBURGH, PA 15205

EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
----------	--------------

1751

DATE MAILED: 03/28/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,178

Applicant(s)

PYLES ET AL.

Examiner

Margaret Einsmann

Art Unit

1751

-- Th MAILING DATE of this communication app ars on the cov r sh et with the correspondenc address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____ .
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 10,11,20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-9 and 12-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9,12-19, drawn to a process of dyeing, classified in class 8, subclass 506 and 576 .
- II. Claims 10 and 11, drawn to a composition of matter, classified in class various subclasses and classes.
- III. Claims 20 and 21, drawn to a dyed article, classified in various classes and subclasses.

The inventions are distinct, each from the other because of the following reasons:

Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different method, for example, being dyed at room temperature or by a high temperature dyeing method.

Inventions II and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the

Art Unit: 1751

apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the produce can be dyed using a different apparatus (dyebath) for example a dyebath containing a solvent and no carrier.

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used for ink jet printing.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with James R. Franks on March 11, 2003 a provisional election was made with traverse to prosecute the invention of group I, claims 1-9, 12-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10, 11, 19 and 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 12-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claims 1 and 3 contain the indefinite term "predetermined". Accordingly, the metes and bounds of said claims cannot be determined.

Regarding claims 2 and 4, they are redundant because the carrier of claims 1 and 3 is inclusive of non-ionic surfactants.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1751

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made:

Claims 1-4, 7-9, 17 and 18 are rejected under 35 U.S.C. 102 (b) as being anticipated by or 103(a) as being unpatentable over Funaki et al, US 4,310,330. Funaki et al disclosed a process of dyeing polymeric materials including polycarbonates with dyeing compositions comprising surfactants. See abstract. In column 4 lines 27 et seq., he gives examples of non-ionic surfactants reading on applicant's claimed carrier, polyoxyethylene alkyl ether type, $R-O-(CH_2CH_2O)_nH$ (line 30) and polyoxyethylene alkylaryl ether type (lines 33-38). In each instance, R is equal to 6 to 25 carbon atoms and n is equal to an integer having from 6 to 25 carbon atoms and n is equal to an integer having a value of 2-50. SEE col 5 lines 55-58. Accordingly, both of the compounds fall within the scope of the carrier as claimed; both are surfactants. The substrate material may be selected from several disclosed polymeric materials including the claimed polycarbonates, polyester and polyalkyl acrylates. See col 7 line 42 to col 8 line 30. Example 2 discloses using an aromatic polycarbonate as the substrate (Col 9 lines 63 et seq.) and example 4 discloses using allyl diglycol carbonate.

Example 4 discloses a process of dyeing a plate of polymerized diethylene glycol bis-allyl carbonate (CR-39) which has a non-fogging coating by heating in an aqueous dyeing bath comprising, 20 g water, 80g of a polyoxyalkyl ether surfactant and 4 grams of an azo type- quinone type blended disperse dye. The disclosure of example 4 anticipates the claims when taken with col 4 lines 27 et seq which defines the variables on the polyoxyalkyl surfactants which patentee uses.

The subject matter is obvious to the skilled artisan because the formula of the surfactant used in example 4 is not defined in that example. It would have been obvious to the skilled artisan that patentee is using a polyoxyalkyl ether surfactant which meets the limits as disclosed in col 4-5 because those are the only polyoxyalkyl ether surfactants disclosed for use Funaki's process.

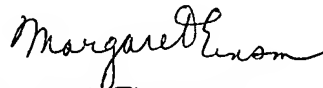
Claims 1-4, 7-9 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Bianco et al, US 3,514,246. Example XI, column 6, wherein aromatic polycarbonate is dyed with an azo disperse dye in the presence of octylphenoxydiethyloxyethanol, anticipates these claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 703-308-3826. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

Art Unit: 1751

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Margaret Einsmann
Primary Examiner
Art Unit 1751

March 14, 2003